

### **REMARKS/ARGUMENTS**

This is in response to the final rejection mailed August 1, 2008.

Applicant cancels claims 68-75 to removed issues. Applicant reserves the right to file such claims in a divisional application.

As pointed out on the last response, both Maquire et al., (U.S. Patent No. 4,686,070) and AAPA point out that one first produce aluminum nitride and the react the formed aluminum nitride with alumina to form aluminum oxynitride. TWO STEP PROCESSES. Clearly, both AAPA and Maquire teach one to first produce AIN and **then take that produced or formed AIN and subsequently process the** produced or formed AIN with alumina to produce ALON. **Applicant teaches one to do the entire conversion in a single step. Further, there is no recognition in Serpek, AAPA, or Maquire that one can produce ALON in a single conversion step process.**

As noted in the final rejection, it is applicant's position that the Examiner is using hindsight to reach the conclusion that the invention set forth in the claims is obvious under 35 USC 103.

In response to this position the Examiner states:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Examiner sees nothing in the present arguments which point out how Examiner's hindsight is improper, thus it is presumed examiner's hindsight of the proper sort, that is, the sort necessary for reconstruction. Examiner understands that it appears that he is asserting the same advantage that applicant discovered - and since this advantage is not recognized in the prior art, it is believed that Examiner used improper hindsight. This is not improper hindsight. Applicant's discovery is a typical engineering discovery: that is, applying routine engineering practices applicant determined the most economical mode of combining ingredients to produce a desired product. Anyone else trying to maximize the economics of the prior art two-step process would have been motivated to test other known advantageous reactors - in particular because it is one of the most important factors in the economy of a process. Such optimization is generally not considered to be innovation.

As noted above, the Examiner states:

But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Now let us consider the "knowledge of the prior art." *The clear teaching of the prior art is that one would use a drum as Serpek at one temperature to produce AIN and then produce ALON from the produced AIN at a different temperature.* Both AAPA and Maguire teach one to first produce AIN and *then take that produced or formed AIN and subsequently process the* produced or formed AIN with alumina to produce ALON. *Applicant teaches one to do the entire conversion in a single step.*

The Examiner indicates one would use a drum for economy but the prior art teaches that making ALON is a two-step process. There is no recognition that one produce ALON in one step *thereby enabling the use of a drum.* The use of a drum for economy *comes from Applicant's one-step process teaching* NOT from the two-step process as taught by the prior art. It is the *Applicant that teaches one to do the entire conversion in a single step-- NOT THE PRIOR ART -- there is no recognition in Serpek, AAPA, or Maquire that one can produce ALON in a single conversion step process.*

*Thus, it is respectfully submitted that the Examiner is using "knowledge gleaned only from the applicant's disclosure".*

As stated by the Supreme Court in *KSR* vs. *Teleflex* cited by the Examiner:

*A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.* See *Graham*, 383 U. S., at 36 (warning against a temptation to read into the prior art the teachings of the invention in issue and instructing courts to guard against slipping into the use of hindsight (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (CA6 1964))). (emphasis added)

In view of the two step teaching to produce ALON it appears that the Examiner is using hindsight in reaching his conclusion rather than following the teachings of the prior art, i.e. a teaching of a two step process to produce ALON. That is, using the teaching of the prior art one would use a drum as Serpek at one temperature to produce aluminum nitride AlN and having formed the aluminum, remove the formed aluminum nitride to react the formed aluminum nitride with alumina at a different temperature to produce ALON. As noted above, both Maguire et al., (U.S. Patent No. 4,686,070) and AAPA point out that one first produce aluminum nitride and then react the formed aluminum nitride with alumina to form aluminum oxynitride. TWO STEP PROCESSES. Certainly it is not the case that processes taught in the prior art to be done in more than one step be done in a single step. Both AAPA and Maguire teach one to first produce AlN and then take that produced or formed AlN and subsequently process the produced or formed AlN with alumina to produce ALON. Applicant teaches one to do the entire conversion in a single step. Further, there is no recognition in Serpek, AAPA, or Maguire that one can produce ALON in a single conversion step process.

Thus, it is respectfully submitted that the Examiner is using "knowledge gleaned only from the applicant's disclosure" and is not using the teaching of the prior art, which teaches a two -step process, and the Examiner is therefore using the precise kind of hindsight cautioned against using by the Supreme Court.

In the event any additional fee is required, please charge such amount to Patent and Trademark Office Deposit Account No. 50-3192.

Respectfully submitted,

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Date

/richard sharkansky/  
Richard M. Sharkansky Reg. No.25,800  
Attorney for Applicant(s)  
P. O. Box 557  
Mashpee, MA 02649  
Telephone: (508) 477-4311  
Facsimile: (508) 477-7234